REMARKS

Claims 15-33 are pending and stand rejected. Claims 15, 23, 29 and 33 have been amended to address certain minor grammatical errors. No new matter was introduced by why of these amendments. Reconsideration of the pending claims is requested in view of the remarks provide below.

Double Patenting

Claims 15-33 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-5 of U.S. Patent No. 6,258,906. Applicants submit herewith a terminal disclaimer, which disclaims U.S. Patent No. 6,258,906. Applicants submit that this disclaimer, in compliance with 37 CFR § 1.321(c) is sufficient to overcome the present rejection.

The pending claims are non-obvious in over Sanchez in view of Busseret

Claims 15-33 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sanchez (U.S. Patent No. 5,548,046) in view of Busseret (U.S. Patent No. 3,849,468).

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art must reference must teach or suggest all the claim limitations. *See In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991), MPEP § 2143.

The Office has alleged that the pending claims are obvious over Sanchez in view of Busseret. According to the Office, Sanchez discloses a method for making dialkyl peroxydicarbonate where an alkyl chloroformate is reacted with an aqueous solution of hydrogen peroxide and then, to the crude dialkyl peroxydicarbonate is added an inorganic salt solution. The Office has alleged that Sanchez differs from the pending claims only in that Sanchez provides for a different method of separation/purification. The Office further alleged that the teachings of Busseret repairs the deficiency in the Sanchez reference and that one of ordinary skill in the art would have been motivated to combine the teachings of these references to achieve the claimed invention. Applicants respectfully disagree.

The cited references of Sanchez and Busseret do not, taken alone or in combination, make out a *prima facie* case of obviousness because there is no motivation to combine these references. Moreover, even if one of ordinary skill in the art were motivated to combine these references, the combination does not teach or suggest all the limitations of the claimed invention. Because of these deficiencies, the cited art does not render the subject matter of the pending claims obvious.

The proposed combination of references does not make out a *prima facie* case of obviousness because the Office has failed to identify an adequate motivation to combine or modify the cited references. The Office alleged in the Office Action that a skilled artisan would have been motivated to use the solvents of Busseret to extract alkyl peroxydicarbonates from the reaction mixture using dimethyl or dibutyl phthalate. The Office goes on to allege that a desire to achieve better separation of an aqueous fraction and higher product purity would drive a skilled artisan to make the proposed combination. However, the Sanchez disclosure is completely silent regarding the need for any improvements. In fact, Sanchez discusses how the stabilized peroxydicarbonate

compositions disclosed therein have utility as initiators of free radical polymerization of compounds such as vinyl chloride (col. 9, line 30-50). Sanchez does not disclose nor does it suggest a process for the manufacture of a solution of dialkylperoxydicarbonates in a solvent but a process for the manufacture of pure dialkylperoxydicarbonates which have to be used as such and not in the form of a solution in a solvent as in the presently claimed invention. Accordingly, in the absence of some showing that the procedures taught by Sanchez were somehow deficient or that those of Busseret are somehow superior, the Office has, at best, provided an obvious-to-try argument. The standard for an obviousness rejection, however is not obvious-to-try. Therefore, the Office has failed to carry its burden and the present rejection should be withdrawn.

In addition to failing to articulate the requisite motivation to combine or modify, the references cited by the Office do not teach all the limitations of the pending claims. Specifically, the pending claims require that an alkyl haloformate be reacted with an inorganic peroxide in water to form dialkyl peroxydicarbonate in an aqueous reaction mixture. The claims go on to require that the inorganic salt be added "to the aqueous reaction mixture." The synthesis method taught by Sanchez does not teach this claimed step.

As noted in the Office Action, Sanchez calls for the addition of a salt solution to the crude dialkyl peroxydicarbonate. What the Office did not mention, however, is that Sanchez requires that the aqueous phase of the reaction be allowed to separate out and then be discarded (col. 6, lines 25-42). Only after the aqueous phase is removed does Sanchez call for the addition of the salt solution (col. 6, lines 44-51). Thus, Sanchez does not teach the addition of an inorganic salt to the aqueous reaction mixture. Rather, Sanchez calls for the addition of an aqueous phase to an organic phase that had been separated from the initial reaction mixture as a wash treatment. The Busseret

reference does not call for the addition of a salt solution to the reaction mixture, thus, Busseret reference does not cure the deficiency in Sanchez. Accordingly, the combination proposed by the Office fails to teach or suggest all the limitations of the claimed invention. As such, the proposed combination fails to make out a *prima facie* case of obviousness.

The present rejection of the pending claims does not articulate a *prima facie* case of obviousness because the Office has failed to articulate a motivation to combine the cited references to achieve the claimed invention. Moreover, the present rejection of the claims does not, even if the two references are combined, teach or suggest all the limitations of the claimed invention. In view of these deficiencies, Applicants submit that the pending claims are non-obvious and request that the present rejection be withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 403162000301.

Respectfully submitted,

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By: _____

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